No. 3004

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

SIMPLEX WINDOW COMPANY,
Appellant,

vs.

HAUSER REVERSIBLE WINDOW COMPANY et al.,
Appellees.

APPELLANT'S REPLY BRIEF.

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APPELLANT'S REPLY BRIEF.

Appellees begin their brief by saying that two questions are involved on the appeal, viz.:

1. *Validity of the claims of the patent in suit;* and

2. *Infringement of said claims.*

We most emphatically deny that the validity of the patent is involved on this appeal, and assert that the only question involved is that of infringement.

In the answer which was filed by the defendant, in the lower court, the validity of the patent was not denied. On the contrary due issuance of the patent was admitted and a general assertion was made in substance that the defendants did not know any-

thing about the validity of the patent and called upon plaintiff to make proof in that behalf. Plaintiff did make proof by offering in evidence the duly issued patent, which carried with it the presumption of validity, and no evidence was offered by defendants in contravention thereof. No prior patent or prior use or prior invention of any kind was pleaded, and consequently none such could have been offered in evidence.

Furthermore, the lower court held inferentially that the patent was valid and based its decision solely on the ground of non-infringement.

In these circumstances it is preposterous for the appellees to assert that the validity of the patent is in issue on this appeal. Nevertheless they present an extended argument to the effect that the patent is void for want of invention, patentable novelty, and aggregation. Those matters are not germane to any issue before this court, and consequently we shall not waste time in attempting to answer them. It is too late to advance such arguments. We repeat that the sole and only question before this court is that of infringement, and we come here with a valid patent, unattacked by any pleading, practically conceded by the appellees at the trial, and inferentially adjudicated by the lower court.

PRIOR ART.

Under this head appellees call attention to three matters, viz.:

1. *Frotscher patent;*
2. *The awning device;* and
3. *The Soule and Larsen patent.*

As to the Frotscher patent little remains to be said. It is a wholly different thing from anything shown in the patent in suit. It is represented by Defendants' Model Exhibit B, and all the court has to do in testing our assertion is to examine the model. As we pointed out in our opening brief (page 11) defendant Fred Hauser testified that this Frotscher device was a wholly useless and worthless contrivance. That testimony disposes of the exhibit in question.

AWNING DEVICE.

This device is referred to by appellees at pages 23 et seq. of their brief. Purported cuts of the same as applied to windows are represented opposite page 23. The first cut is not truly representative of the old awning device as used in practice. Your Honors can see this if you will examine one of these awning devices the next time you walk down Market Street. This cut is purely fictitious, and the model (Defendants' Exhibit I) from which it is supposed to be made is faked. Neither the model nor the drawing is a correct representation of the old awning device. The testimony of the witness Vale in substantiation of this statement will be found at pages 55 et seq. of the record, and substantially similar testimony by the defendants' witness Behnke

will be found at pages 64 et seq. of the record. We submit, therefore, that this cut and this model must be entirely disregarded.

But furthermore, the cut itself, even as made, is not capable of the functions performed by the Soule patent. The structure of the cut is not reversible, nor is it capable of being held in stable equilibrium at any desired point. These are the two functions of the Soule window. They are not found in the awning structure. In the old awning structure when the cord or latch which holds the awning folded up against the window is released, the awning falls down to its extreme limit by gravity, the lower rod extending out horizontally from the window, and there rests in that one stable position until it is folded up again. It can not be automatically manipulated so as to be held in any other position of stable equilibrium, and the only way that such result can be accomplished is to manually bring it into such a position, and then manually tie or latch it there, which, of course, is a different mode of operation from that of the Soule window.

Nor is the awning capable of reversibility. Indeed there would be no occasion to reverse it, even if one desired to do so. Its mode of use is to be folded out completely when in operation, and to be folded up completely when out of operation. No reversibility is desirable or possible. With the window, reversibility is desirable for the purpose of enabling the operator to wash the glass. Thus we see that the object to be accomplished and the

mode of operation are both different in the two cases.

Referring to the second cut shown opposite page 23 of the appellees' brief, that is stated to be an "awning device attached to the sash". But that is purely a hypothetical and visionary figure. Appellees use it for the purpose of showing how they think the old awning device could be applied to a window for the purpose of reversing the sash and holding it in stable equilibrium at any desired point. What we have said regarding cut 1 applies with even greater force to cut 2. We repeat, both cuts are visionary and fictitious. Neither one represents any actual structure of the prior art. Therefore, they should be disregarded.

The model and drawing have been purposely made to vary from the actual awning structure of the prior art in order to simulate the Soule window structure. Note the fact that in the drawing the lower end of arm 7 has been carried down to the bottom of the window and there provided with a sliding mechanism. No such construction was ever shown anywhere in an awning. Note, also, the fact that this arm 7 is shown as inclined at an angle of 45°, similar to Soule; whereas in the actual awning this arm 7 extends outward on a horizontal. Soule's arm could not under any conceivable condition of operation assume the horizontal position.

Note, also, the fact that in the drawing the upper end of the arm 7 is provided with a pivot 9. No such pivot is found in an awning, nor is there

any necessity for one at that point. One edge of the cloth is permanently attached to the arm at that point, and the other edge to the window so that the awning will fold and unfold like an umbrella. Indeed, the awning is no nearer to Soule's window structure than an ordinary umbrella.

But whatever the awning structure may be, we insist that at this stage of the controversy it cannot be used to impeach the patent. The question of validity of the patent is not before the court. The only question before the court is that of infringement upon the patent, and that necessarily concedes validity.

SOULE & LARSEN PATENT.

Appellees profess to rely upon the Soule & Larsen patent as a prior device and a part of the prior art, arguing therefrom that its effect is to invalidate the patent in suit. In reply we assert that the Soule & Larsen patent is no part of the prior art and can not be used for any such purpose as that for which the appellees use it. That patent was applied for on October 31, 1911. The Soule patent in suit was applied for on August 21, 1912, and was issued on September 9, 1913, whereas the Soule & Larsen patent was not issued until two years afterwards, on November 9, 1915. The two patents were co-pending applications in the U. S. Patent Office. Consequently, the Soule & Larsen patent is not a prior patent, nor is it any part of the prior art.

Co-pending applications by the same inventor, no matter which was filed first, can not be used to anticipate or avoid each other. This was decided by the Court of Appeals for the Eighth Circuit in *Century Electric Co. v. Westinghouse,* 191 Fed. 350, and at page 352 of the Reporter many cases are cited in support of the decision.

It is well settled that where the alleged prior patent was filed before, but was not issued until after, the issuance of the patent in suit, such alleged prior patent is not anticipatory.

General Electric Co. v. Allis, 190 Fed. 166;
Box Co. v. Gumb, 231 Fed. 274;
Bates v. Coe, 98 U. S. 31;
Dubois v. Kirk, 158 U. S. 64.

And the courts have even gone so far as to hold that the alleged prior patent is not anticipatory even though it was actually issued prior to the issuance of the patent in suit, so long as the patent in suit was co-pending with the other patent in the Patent Office, prior to the issuance of either of them.

Vacuum Co. v. Dunn, 209 Fed. 221;
Gray v. Baird Mfg. Co., 174 Fed. 417;
Anderson v. Collins, 122 Fed. 451.

Furthermore, the witness Soule testified that he made the invention of the Soule patent in the beginning of 1911 (Rec. 44). Now, inasmuch as the Soule & Larsen patent was not applied for until October 31, 1911, it is apparent that the invention of

the Soule patent was as a matter of fact actually made many months prior to the application for the Soule & Larsen patent. For that reason, if for none other, the Soule & Larsen patent could not be considered as an anticipatory patent or as a part of the prior art. Consequently, the Soule & Larsen patent cuts no figure in this controversy and must be wholly eliminated from consideration.

But furthermore, the invention of the Soule & Larsen patent, if it be an invention, is wholly different from that of the Soule patent. In the Soule & Larsen patent it is true that there is shown an adjuster arm, designated by the numeral 16 in the drawing, but the only way in which that adjuster arm can operate to maintain the window frame in stable equilibrium is by the use of another arm attached to the window sash and provided with notches to engage a lug placed on the adjuster arm. The operation is that of a positive, permanent locking device, similar to a gate latch. When the notch engages the lug, the window frame is locked. This requires a manual operation. The operator must first open the window to the point where he desires it to be held and then manually engage the notched arm with the lug. The window then remains permanently in that position just as a door or gate when it is locked. To change the position the operator must unlock the device and move the window to another position, and then again manually lock it. There is no automatic operation, but

purely a manual one of successive locking and unlocking, latching and unlatching.

But in the case of Soule's window, all that is necessary to do is to push the window open to the desired position and leave it there. The retention of the window in that position is automatic. It was for these reasons that we acquiesced in the ruling of the lower court regarding the Soule & Larsen patent. The distinction between the two devices is apparent. The Soule & Larsen device is a manual lock: the Soule device is an automatically-operated device for holding the window in any desired position against ordinary strains. Automatic mechanism is not an equivalent of manually-operated mechanism. *E. N. Rowell Co. v. William Koehl Co.,* 240 Fed. Rep. 956-61; *Hobbs v. Beach,* 180 U. S. 390 et seq.

APPELLEES' PATENT.

Defendant Hauser secured a patent, No. 1,114,260, dated October 20, 1914, some two years after the application of Soule for his patent, and a year after the actual issuance of the Soule patent. The structure of defendants' window is that shown in this Hauser patent.

Appellees seek to invoke some kind of a presumption which they say arises from the issuance of this subsequent patent. Their precise contention is that the issuance of this subsequent patent raises a presumption that the structure therein shown is not

an infringement of any prior patent. In reply to this we say that there is no such presumption under the law. The only presumption which arises on the issuance of a subsequent patent is that the claims of the subsequent patent are not anticipated by any prior patent. Or, to put it in a little different language, that there is *a patentable difference* between the claims of the subsequent patent and any prior structure. *There is no presumption whatever that the structure described in the subsequent patent is not an infringement of any prior patent.*

The latest case on this subject is that of *General Electric Co. v. Electric Controller Co.,* 243 Fed. 188, decided by the Court of Appeals for the Sixth Circuit, on May 18, 1917. From page 193 of the opinion we read:

> "In this connection it is to be observed that the defendant has a patent upon its form of device and insists upon the benefit of some presumptions from this patent. We do not need to repeat that the issue of the later patent raises no presumption of non-infringement, and usually does not even tend to establish that conclusion. The contrary claim confuses the presumption of patentable difference with the presumption of non-infringement."

In support of this the court cites the cases of

Herman v. Youngstown, 191 Fed, 584; and
Curry v. Union Co., 230 Fed. 429.

In addition thereto we cite the cases of

Murray v. Detroit. 206 Fed. 467;
Rowley v. Columbus, 220 Fed. 128, 137.

The appellees cite in this behalf the decision of this court in the case of *Ransome v. Hyatt,* 69 Fed. 148; but the only thing the court decided there is that the issuance of a subsequent patent "creates a *prima facie* presumption of a patentable difference from the machine of the complainant's patent". This is far from holding that the subsequent patent raises a presumption of non-infringement. Indeed, the Ransome case is in direct harmony with the rule laid down in the cases we have cited, and that is that the subsequent patent merely raises a presumption that its *claims* possess a patentable difference over prior devices. It is elementary law that a subsequent device may be patentable and yet may be an infringement of an antecedent patent. That is all that we have here. The issuance of the Hauser patent creates a presumption that there was something patentable in his construction, but it does not create any presumption that said construction was not an infringement of the Soule patent.

This question is one which has created some confusion at times by reason of the loose language used in some of the decisions, but when it is carefully analyzed it will be found to be free from doubt, and the law on the subject is as we have above stated.

INFRINGEMENT.

This is the sole and only question involved on this appeal. We base our contention of infringement

on the rule stated at Sec. 348 of *Walker on Patents* and a great number of cases upholding that citation. The rule is simply this:

Changing the relative position of one or more of the elements of a machine does not avert infringement where the transposition does not effect a new result or embody a new mode of operation.

Of course the corollary from this rule follows that where the transposition does effect a new result or embodies a different mode of operation, then the rule does not apply.

Therefore, the questions for consideration here are: (1) Is there any different result accomplished by the Hauser structure? and (2) Is there any difference in the mode of operation?

It goes without saying that the first question must be answered in the negative. There is no difference in result. Both structures accomplish identically the same thing, to wit, (1) reversibility of the window for the purpose of washing, and (2) retention of the window in stable equilibrium at any desired point to resist ordinary strains from which it would otherwise be closed up.

The second question also must be answered in the negative. The two windows operate on the same principle and by the same mode of operation. The sole and only difference in mechanical construction is this: that whereas in the Soule window the lower end of the adjuster arm is slidably pivoted in the frame, and the outer end of the carrier arm rigidly

pivoted therein, in the Hauser structure the lower end of the adjuster arm is rigidly pivoted in the frame, and the upper end of the carrier arm slidably pivoted in the sash. This is merely a reversal of parts. Both structures have the same elements, to wit, adjuster arm, carrier arm, and sliding mechanism used in connection therewith. It is wholly immaterial whether the sliding mechanism be located in the frame or the sash. Soule locates it in the frame, Hauser locates it in the sash. This is a mere change of location. No new result is accomplished. Both devices accomplish identically the same result and by the same mode of operation. They are therefore mechanical equivalents. This presents the entire controversy in a nutshell, and no argument could change the facts. It is a plain, simple case for application of the well settled rule of law quoted. Does that rule apply, or does it not apply? If it does apply, then there was an infringement, and the judgment must be reversed.

Counsel for appellees say that as they view the matter it is not a question of changing the relative position of the parts of the machine, but of *re-arrangement* and *re-construction* of the whole machine. This is begging the question. We admit that there is a re-arrangement in certain minor particulars; but that does not avoid infringement, because the further question then remains, does such re-arrangement result in any different function or any changed mode of operation? It can not be denied that the result is the same, and as to the

mode of operation we contend that there is substantial equivalency. Certainly both windows are reversible. That can not be denied. It is equally certain that both windows can be held in stable equilibrium at any desired point against ordinary strains and thereby be prevented from closing up. It is equally certain that this is accomplished by the use of the adjuster arm, carrier arm, and sliding mechanism, and the only difference is as to the location of certain of the parts. In fine, the only difference is that in the Soule structure the sliding mechanism is located in the frame, whereas in the Hauser structure the sliding mechanism is located in the sash. This change of position in the sliding mechanism necessitates a change in pivoting. That is to say, the sliding pivoting of the adjuster arm in the Soule is changed to a rigid pivoting, and the rigid pivoting of his carrier arm is changed to a sliding pivoting, all without producing the slightest change in result. Is not that equivalency?

This question is further answered by Plaintiff's Exhibit No. 6, which is a model of a window provided on one side with the Soule mechanism, and on the other side with the Hauser mechanism. Both sides work in perfect harmony. Where one device can be substituted for another without change of function, it is an equivalent. In other words, interchangeability of two elements betokens equivalency.

Ball Bearing Co. v. Star Co., 147 Fed. 721 (affirmed in 149 Fed. 219).

In closing, we can not refrain from calling attention to many errors both of fact and theory contained in the appellees' brief.

At the top of page 4 it is said that the force which holds the adjuster arm and sash in a fixed stable position is "the frictional force of the slidable devices in the slot at 12". This is an error. There is no frictional force at the point 12 of the Soule patent other than such frictional force as would naturally follow a freely flowing slide. According to the patent 12 is a sliding block moving freely up and down in the slot 20, and there is no device provided at that point to secure frictional resistance. The frictional resistance of the Soule device which holds the window in any desired position, is at the top part of the frame where the upper end of the sash is provided with a device for the purpose of obtaining frictional resistance.

Again, at the bottom of page 4 and top of page 5 appellees repeat the error by asserting that the frictional devices at 12 are "amply sufficient to hold the sash in stable equilibrium for all practical and useful purposes". This is wholly erroneous, more so even than the former statement. The devices at 12 consists of a freely sliding block, and the essence of its construction is that it should be freely sliding and not capable of offering resistance.

Near the middle of page 6, it is stated that the carrier arm 4 is wholly controlled by the adjuster arm 7. The reverse of this is true. The adjuster arm 7 is controlled by the carrier arm 4.

At the top of page 7 it is stated that the name "carrier arm" as applied to Soule's arm 4 is misleading in that it carries nothing, but is carried by the adjuster arm 7. This is not a correct statement. On the contrary the arm 4 is rigidly attached at its upper end to the window frame and at the other end to the adjuster arm, and the adjuster arm in turn is attached to the sash. Consequently, the arm 4 supports or "carries" both the adjuster arm and the sash, and in the true sense of the term is a "carrier arm". But what of it, if the term "carrier arm" *is* a misnomer? The patent law deals with things and the functions of things, not merely with the names of things, and if a patentee should be so unfortunate as to misname one of the elements of his machine, the matter is of no consequence as affecting the validity of the patent.

At page 28, when referring to the Hauser patent, it is asserted that the Hauser link 19 does not act to support the sash or the adjuster arm 24; but this statement is immediately contradicted by the brief when it proceeds to say that the only function of the link 19 is in the nature of a retarding device "and to some extent, perhaps, retards the sash in its upward or downward movement".

At the middle of page 29, it is asserted that Hauser's link 19 is "a sort of locking device, more like the notched locking arm of the Soule-Larsen patent than the arm 4 of the Soule patent". This is not correct. The notched arm of the Soule-Larsen patent is that of a positive, absolute lock. No such

function inheres in Hauser's link 19. On the contrary the link 19 acts in the same capacity as Soule's arm 4 and divides the weight of the sash.

At the middle of page 30 it is asserted that Hauser's link 19 has nothing to do with the general equilibrium of the device nor with the shifting of the sash, nor with the supporting of the adjuster arm or sash. This is entirely inaccurate. It has a great deal to do with all of the things mentioned. In proof of that remove the link 19 entirely and the device becomes impractical and does not perform the function it was intended to perform.

At page 31, it is asserted that there is no interchangeability between arm 7 of Soule's patent and the arm 24 of Hauser, nor between arm 4 of Soule's patent and link 19 of Hauser. This is likewise erroneous, and in proof of the same we have merely to refer to the Plaintiff's Exhibit 6, which consists of a Soule window, on one side of which the Soule patented structure has been removed and Hauser's structure substituted, while the other side retains the Soule structure. In other words, on one side of the window there is that "interchangeability" which counsel says is an important test of equivalency.

At page 35, it is asserted that Soule did not discover or invent the idea of having a supporting arm slidably connected with the frame at the bottom nor the idea of having a carrier arm. We most emphatically deny these assertions. He did discover and invent the things mentioned, and he was the

first in the art to produce them. Hauser gives to these things the tribute of his praise by using them or their mechanical equivalents.

We submit that the judgment is erroneous and should be reversed.

Dated, San Francisco,
October 20, 1917.

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